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38834 7590 12/27/2010 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			EXAMINER AMAKWE, TAMRA L	
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Mailed :
In re application of
Nathalie Vast
Serial No. 10/541202
Filed: May 10, 2006
For: SHEET WITH AN ANTICOPYING, REDUCED OPACITY

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DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.144 TO WITHDRAW THE RESTRICTION REQUIREMENT mailed June 23, 2009 and made final in the office action mailed October 01, 2009.

On June 23, 2009, a restriction requirement, under 35 U.S.C 121 and 372 was made by the examiner. The restriction requirement set forth two groups. The requirement stated that the inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature *a priori*. Applicant traversed the restriction requirement in a response filed July 20, 2009. The examiner made the requirement final in the non-final office action mailed October 01, 2009.

On October 01, 2010, the instant petition under 37 CFR 1.144 was filed to formally request the withdrawal of the restriction requirement.

Applicant's position for the withdrawal of the restriction requirement is that the requisite criteria for a proper restriction requirement and the criteria for rejoinder have not been met.

DECISION

The instant application has been filed under 35 U.S.C. 371 as a national phase application of PCT/FR03/03874 and as such is subject to the unity requirements set out in PCT Rules 13.1 – 13.4 and 37 CFR 1.475, as well as the PCT Administrative Instructions, Annex B.

To support's applicant's position that the restriction requirement is that the requisite criteria for a proper restriction requirement have not been met, applicant submits that claims 1 and 4 are specifically subcombination B^{sp} and combination AB^{sp}, and directs the Office's attention to MPEP 806.05(c)(I). Applicant also asserts that unity of inventions exists between the inventions

listed as Groups I-II under PCT Rule 13.1 as the inventions of Groups I-II have the same or corresponding special technical feature, and refers the Office to MPEP 1893.03(d). To substantiate the assertion, Applicant notes that the claims listed with the invention of Group II recite a dependency to claim 1 of Group I.

Regarding Applicant's submission that the restriction requirement is improper because the inventions listed as Groups I-II are subcombination and combinations, and that the subcombination is essential to the combination, MPEP 806.05(c) (I), Applicant is reminded that the restriction requirement issued was under 35 U.S.C 121 and 372, not under the U.S. restriction practice provided at MPEP 806.05(c) (I). Hence, this argument is not persuasive.

Regarding Applicant's assertion that the inventions of Groups I-II have the same or corresponding special technical feature, it should be noted that the PCT Administrative Instructions, Annex B, Part 1 at (b) state that "the special technical features" common to all groupings of inventions shall be defined, as in PCT Rule 13.2, to mean,

"those technical features which each of the claimed inventions, considered as a whole, makes over the prior art." (Emphasis added)

In the instant case, it is noted that the restriction requirement stated that the inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature *a priori*. It is further noted that in response to Applicant's traversal, the examiner found Applicant's traversal unpersuasive because there is lack of unity *a posteriori*. To support the examiner's position, the examiner cited Fan et al. for teaching two-sided printed indicia. The examiner found that the technical feature shared between the groups failed to define a contribution over the prior art.

A review of the restriction requirement, it is found that the requirement is improper in asserting that the inventions of Groups I-II lack the same or corresponding special technical feature. This position is further evidenced by the of the non-final office action mailed to Applicant on October 01, 2009, which recognized that the technical feature shared between the groups is two-sided printed indicia.

It is also found that the non-final office action has incorrectly identified two-sided printed indicia as the technical feature shared between the groups. The technical feature shared between the groups is a paper comprising a screen region comprising an average overall opacity less than the opacity of the vellum part of the paper, wherein said screen region being made up from alternations of vellum mini regions, and have an approximately constant thickness equal to that of the vellum part of the rest of the paper and of the mini regions of reduced opacity because of their smaller thickness compared with the vellum mini regions. In the absence of prior art demonstrating that this shared technical feature fails to provide a contribution over the prior art, the shared technical feature is a special technical feature. In the instant case, the examiner has failed to establish that the inventions lack unity *a posteriori*.

Accordingly, after review of the restriction requirement and the action taken by the examiner in response to Applicant's election, the petition to withdraw the restriction requirement and

rejoinder of all claims to the nonelected invention is **Granted**. The application is being forwarded to the examiner to rejoin all claims to the nonelected invention that depend from or otherwise require all the limitations of an allowable claim and act accordingly.

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